



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**SILVERBROOK RESEARCH PTY LTD**  
**393 DARLING STREET**  
**BALMAIN 2041 AU AUSTRALIA**

**COPY MAILED**

**FEB 20 2009**

**OFFICE OF PETITIONS**

In re Application of	:
Silverbrook et al.	:
Application No. 10/760,214	: DECISION ON PETITION
Filed: January 21, 2004	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. WAL15US	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 19, 2007, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional

parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., August 2001), Section 201.11, Reference to First Application. The amendment filed March 19, 2007 fails to state the relationships of all the applications listed to the instant application.

If petitioner merely wishes the applications listed as co-pending applications, a petition under 37 CFR 1.78 is not necessary and a refund of the petition fee may be requested. 37 CFR 1.78 is only necessary when claiming the benefit of the prior applications.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a substitute amendment<sup>1</sup> stating the relationship of the prior-filed application to the instant application is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop PETITIONS  
                                    Commissioner for Patents  
                                    Post Office Box 1450  
                                    Alexandria, VA 22313-1450

By hand:                     Customer Window located at:  
                                    U.S. Patent and Trademark Office  
                                    Customer Service Window Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

By fax:                        (571) 273-8300  
                                    ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3206.

/Liana Walsh/  
Liana Walsh  
Petitions Examiner  
Office of Petitions

---

<sup>1</sup> Note 37 CFR 1.121